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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER ALVAREZ, RAQUEL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/001,772
Filing Date: October 31, 2001
Appellant(s): SUBRAMANIAN ET AL.

Thomas J. Bean
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/5/2009 appealing from the Office action mailed 2/25/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,076,443	Emens	7-2006
5,835,087	Herz	11-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15, 16, 21, 22, 27-32, 33-36, 37-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al. (7,076,443 hereinafter Emens) in view of Herz et al. (5,835,087 hereinafter Herz).

With respect to claims 15, 16, 21, 22, 27-31, 33-35, 37-89, Emens teaches a system for delivering ads to a user operating a station connected to a distributed computer network (Abstract). An ad server which maintains the ads for the user at the station across the distributed network, the user station allowing the user to retrieve information containing content (Figure 3, 110); a data store that identifies a set of rules associated with each ad, the rules indicate a level of relevancy of the ad to the content of the information retrieved (Figure 3, 140); a match maker that accesses the content retrieved by the user, extracts the content according to its rules, parses the content of the information by objects, free of information about the user (col. 4, lines 54-58) and targets an ad from the server to the content by applying the rules in the data store, and directly sends the targeted ad to the station for display with the content (Figure 3, 160 and corresponding text, specially col. 7, lines 11-17 which discloses **The search result items and associated product icons** are then displayed to the **browser 100**).

With respect to the newly added feature of the content being accessed in response to the submission of a URL by the user. Herz teaches on Figure 10, 1102 a user accesses a news site and the articles delivered to the users are based on the

Art Unit: 3688

user's submission. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have replaced Emens keyword search with the teachings of Herz of the content being accessed in response to the submission of a URL by the user because such a motivation would avoid **unwanted articles in an irrelevant or unexpected context** (Herz, col. 2, lines 43-53).

Claim 32 further recites that the performance is measured by click through rates of targeted ads. Official notice is taken that is old and well known in the computer related arts to monitor the amount of click through of an ad in order to measure how effective or attractive is the advertisement being presented. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included measuring the performance by click through rates of the ads in order to obtain the above mentioned advantage.

Claim 36 further recites that the content is classified is related to past consumption by users as a consequence of ads that were received and responded to. Official notice is taken that is old and well known to classify information related to past consumption of prior products or coupons redemption by the consumer in order to better target consequent ads to the users. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the content being classified is related to past consumption by users as a consequence of ads that were received and responded to in order to obtain the above mentioned advantage.

(10) Response to Argument

Appellant argues that Emens doesn't teach displaying the requested content and the targeted ad together. The Examiner wants to point out that Emens teaches on col. 7, lines 11-18, "the request server **60** then builds a results page which contains the search result items, and if the search result item was flagged as a having a product match, a product icon or graphical user interface designator is also displayed for subsequent user selection. **The search result items and associated product icons are then displayed 98 to the browser 100**". As stated clearly from Emens above, the search result item is displayed along with the matching product icon. The product icon is a targeted advertisement based on the search result. Emens clearly teaches the recited claim limitation of "**directly send the targeted ad to the station for display with the content**" as stated above, in Emens, the targeted product icon is sent to the user station along with the search result (Emens col. 7, lines 11-18).

Appellant argues that in Emens the user has to click on the product icon and that in the instant invention the user does not, the Examiner wants to point out that the instant claims do not recite in what format the advertisements are presented to the user and therefore the claimed invention are met by Emens displaying the search results and targeted product icon to the user.

With respect the content being accessed in response to the submission of a URL by the user. The Examiner wants to point out that in Herz the user inputs the URL in order to receive content from a particular website and in Emens the user inputs

Art Unit: 3688

keywords in order to receive the content. Modifying Emens to incorporate Herz teachings will produce a system wherein the user uses the URL instead of keywords to receive the content. This change is obvious and well known for users to use company's URL in order to obtain direct access to the information needed and therefore contrary to Applicant's arguments, the references do not teach away from each other.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that the references do not teach a set of relevancy rules associated with each ad. The Examiner disagrees with Appellant because Emens clearly teaches on col. 4, lines 54-58, "The method of the instant invention follows an approach uniquely different from the e-commerce method of user profiling. Instead of using user profiles to target advertisement, the resultant **search result items** from a search engine performing an Internet search are utilized. These **search result items** are **associated with similar or related advertisements**." The advertisements displayed to the users matches the search result item, as can be seen by above the ads are based on relevancy rules associated with the search results and not based on profiling or any information about the user or any intervening entities.

With respect to the official notice taken by the Examiner that monitoring the amount of click through of an ad and classifying information based on past consumption of prior products or coupons redemption by the consumer are well known. Applicant

Art Unit: 3688

asserts that Emens or Herz do not teach such functions, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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